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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,491	11/14/2003	Masahiro Yatake	U 014890-5	1032
140 7590 03/08/2007 LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/714,491

Applicant(s)

YATAKE, MASAHIRO

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections are overcome by applicant's amendment filed 12/18/06.

The new grounds of objection and rejection set forth below are necessitated by applicant's amendment and thus, the following action is final.

Claim Objections

2. Claims 4 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 4 and claim 24, which depend on claim 1 and claim 23, respectively, each recite "methylisothiazolone content is no more than 500 ppm" while claim 1 and claim 23 each recite "methylisothiazolone content is at least 10 ppm". Thus, claim 4 and claim 24 each fail to further limit the scope of the claim on which they depend, namely, claim 1 and claim 23 respectively, given that claim 4 and claim 24 are each broader than the claim on which they depend. That is, claim 4 and claim 24 each include values of methylisothiazolone content less than 10 ppm which is outside the scope of each of claim 1 and claim 23, respectively.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) Claim 1 has been amended to recite “wherein the methylisothiazolone content is at least 10 ppm and is an amount that, in consideration of the octylisothiazolone content and the combined amount of methylisothiazolone and octylisothiazolone, would result in ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is no more than 1.2 times greater than viscosity of the ink before storage” while newly added claim 23 also recites the same cited phrase. It is the examiner’s position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the cited phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the above amendment, applicant point to page 17, lines 21-27 and Table 3, page 18 of the present specification.

However, with respect to the amount of methylisothiazolone, it is noted that while these portions of the present specification provide support to recite amounts of methylisothiazolone of 10 ppm, 100 ppm, 200 ppm, 500 ppm, and 800 ppm, which, in consideration of the octylisothiazolone content and the combined amount of methylisothiazolone and

octylisothiazolone, would result in ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is no more than 1.2 times greater than viscosity of the ink before storage, does not provide support for any amount of methylisothiazolone of at least 10 ppm or greater as presently claimed. That is, there is no support for amount of methylisothiazolone of, for instance, 50 ppm, 200 ppm, 600 ppm, etc. which, in consideration of the octylisothiazolone content and the combined amount of methylisothiazolone and octylisothiazolone, would result in ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is no more than 1.2 times greater than viscosity of the ink before storage.

Further, with respect to the viscosity, it is noted that while page 17, lines 21-27 provides support to recite ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is 1.0 to no more than 1.2 times greater than viscosity of the ink before storage, does not provide support to recite ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is no more than 1.2 times greater than viscosity of the ink before storage which includes values of final viscosity after storage that are less than 1.0 times greater than the viscosity of the ink before storage, i.e. 0.01, 0.5, 0.8, etc. for which there is no support in the specification as originally filed.

(b) Newly added claim 22 recites “wherein the methylisothiazolone content is in an amount that, in consideration of the octylisothiazolone content and the combined amount of methylisothiazolone and octylisothiazolone, would result in ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is no more than 1.1 times greater than viscosity of the ink before storage”. It is the examiner’s position that this phrase fails to satisfy

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the written description requirement under the cited statute since there does not appear to be a written description requirement of the cited phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the above amendment, applicant point to page 17, lines 21-27 of the present specification.

However, it is noted that while page 17, lines 21-27 provides support to recite ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is 1.0 to 1.1 times greater than viscosity of the ink before storage, does not provide support to recite ink having a final viscosity after storage in a stoppered vial for 30 days at 70 °C that is no more than 1.1 times greater than viscosity of the ink before storage which includes values of final viscosity after storage that are less than 1.0 times greater than the viscosity of the ink before storage, i.e. 0.01, 0.5, 0.8, etc. for which there is no support in the specification as originally filed.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Callie E. Shosho
Primary Examiner
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